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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,784	12/30/2003	Michael Ray Tiller	146712015100	4479
50269	7590	02/27/2006		
SEAGATE TECHNOLOGY c/o MOFO SF 425 MARKET ST. SAN FRANCISCO, CA 94105			EXAMINER FOOTLAND, LENARD A	
			ART UNIT	PAPER NUMBER
			3682	
DATE MAILED: 02/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,784	Applicant(s) TILLER ET AL.	
	Examiner Lenard A. Footland	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election with traverse of the species of Fig('s). 4-6 remains. Claim(s) 11-20 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to non-elected species, not all claims depending upon or otherwise including the limitations of an allowed generic claim

Applicant is reminded that if the amendment of any claims results in a change of the species they read upon, that is required to be indicated. In addition, if any new claims are added, it is required that the applicant indicate which of them read on the elected species. Failure to do so will result in a holding of nonresponsiveness.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim(s) 1-6 and 8-10 are rejected under 35 U.S.C. § 102(e), as being anticipated by Heine et al. '540 ("Heine"). The examiner finds all claimed subject matter to be present.

See front page Fig and capillary near 104.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim(s) 7, 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Heine as set forth in the rejection of claim(s) 1-6 and 8-10 above, and further in view of official notice of common knowledge in the art, or, in the alternative, engineering design choice.

The examiner finds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the additional feature(s) in question since it was known in the art to do so to provide the function(s) disclosed.

Alternatively, the examiner finds that the broad provision of this/these features *vis-à-vis* that/those disclosed by the reference solve(s) no stated problem insofar as the record is concerned and, accordingly, would have been an obvious matter of design choice. See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

This application contains claims drawn to an invention non-elected with traverse. A complete response to the final rejection must include cancellation of non-elected claims or other

appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01. Failing this, an application otherwise ready for allowance will be taken to have authorization to have such claims canceled by examiner's amendment.

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant appears to have responded to the wrong Heine reference.

Since applicant submitted two Heine references, among over forty references submitted by applicant, applicant should have checked all the references that he himself submitted. The Heine reference applicant responded to clearly was not relevant to his claims. The Heine reference employed by the examiner clearly is anticipatory. The applicant reviewed or should have reviewed all of the references submitted by himself to make sure there were not two references of the same name. The applicant knew or should have known that there were two Heine references submitted by himself, knew or should have known that one was relevant and one was not, and could easily have called the examiner for confirmation if he had any question. In response to a REQUEST FOR INFORMATION the applicant listed the least relevant Heine reference as being more relevant.

It is the examiner's normal practice, in an excess of caution, to identify by number any reference employed with the same name as

one cited. This does not, however, relieve the applicant of his normal duty to keep track of references that he himself has submitted, in large numbers. In fairness to the public, therefore, applicant's failure to avail himself of knowledge he knew or should have known will not prevent this action from being made final.

In response to Applicant's arguments, 37 CFR § 1.111(c) requires applicant to "clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections." In this case, applicant has failed to clearly point out patentable novelty and failed to show how the amendment avoids the combination of references applied against the claim.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS

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MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenard A. Footland, whose telephone number is (571) 272-7103.

A handwritten signature in cursive script, reading "Lenard A. Footland".

Lenard A. Footland

Primary Examiner

Technology Center 3600

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laf

February 21, 2006